

R marks

Applicants request a reconsideration of the present patent application in view of the above amendments and following remarks. Claims 4, 6, 13 and 24 have been amended, claims 26-28 have been added, and no claims have been cancelled. Therefore, claims 4-9, 13-16, 18 and 24-28 are pending in the application.

Claims 4, 5, 13-16 and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,992,360 to Elendt et al. ("the Elendt reference"). Applicants respectfully traverse this rejection.

Amended claim 4 is directed to a valve deactivation system having a deactivation rocker arm assembly, a locking pin assembly, and a free motion spring assembly. The deactivation rocker arm assembly includes an elongate rocker arm having an end, an aperture defined by the end, and a center post slidingly disposed within the aperture. The center post defines a middle pin bore and is configured for engaging a valve stem of a valve of an internal combustion engine. The end of the rocker arm defines a first pin bore and a second pin bore that are substantially concentric relative to each other. The locking pin assembly selectively couples together and decouples the center post and the rocker arm. The locking pin assembly includes an actuating pin member, a second pin member and a middle pin member. The actuating pin member is slidingly disposed at least partially within the first pin bore, the second pin member is slidingly disposed at least partially within the second pin bore, and the middle pin member is slidingly disposed at least partially within the middle pin bore. In

addition, the actuating pin member is in contact with the middle pin member and the middle pin member is in contact with the second pin member to conjunctively form the locking pin assembly.

None of the references of record teach or suggest a valve deactivation system having an actuating pin member in contact with a middle pin member and the middle pin member in contact with a second pin member as recited in amended claim 4. Instead, the Elendt reference is directed to a valve drive having a 2 member pin assembly operating in one direction as shown in FIG. 1 or dual, 2 pin assemblies acting in opposing directions, as shown in FIG. 3. Specifically, FIG. 3 shows one locking cap (18) acting against a first spring loaded locking piston (16) and a second locking cap (18) acting against a second spring loaded piston (16) in the opposite direction. When hydraulic pressure is applied against the 2 locking caps, one of the locking caps pushes against its mating locking piston generally in a downward direction as shown in the figure, and the other of the 2 locking caps pushes against its mating locking piston generally in an upward direction as shown in the figure. While the multiple caps and pistons shown in FIG. 3 may be interpreted as being actuating, middle, and second pin members, FIG. 3 does not disclose an actuating pin member being in contact with a middle pin member and the middle pin member being in contact with a second pin member as recited in amended claim 4.

Since the Elendt reference fails to disclose every element included in claim 4, Applicants request that the rejection of claim 4 be withdrawn. As claim 5 depends from claim 4, this claim is also not taught or suggested by the

references of record for at least the same reasons set forth with respect to claim

4.

Claim 5 recites additional features that further distinguish the present invention from the references of record. For instance, claim 5 recites in part that the actuator pin member extends away from the center post when the pin spring biases the locking pin assembly toward the default position. In contrast, the locking pistons (16) in the Elendt reference are biased toward the hydraulic clearance compensation element (6) and insertion element (8) by the spring (15) when the valves are moving toward the default position as shown in FIGS. 1 and 3.

Moreover, claim 5 states that the middle pin member extends from disposition within the middle pin bore into the first pin bore when the pin spring biases the locking pin assembly toward a default position. While the locking cap (18) in the Elendt reference is permitted to slide within the bore (12) formed in the insertion element (8), as best seen in FIG. 1, the locking cap (18) has an outwardly extending rim that is adapted to abut a guide sleeve (17) to prevent the locking cap (18) from extending outside the bore (12) formed in the insertion element (8). Thus, the locking cap (18) does not extend from disposition within the bore (12) into the bore (11) formed in the rocker arm (1). For these additional reasons, Applicants request that the rejection of claim 5 be withdrawn.

Amended claim 13 is directed to a deactivation rocker arm assembly including an elongate rocker arm, a center post, and a locking pin assembly. The elongate rocker arm has an end and an aperture defined by the end. The end

defines a first pin bore and a second pin bore, wherein the first pin bore and the second pin bore are substantially concentric relative to each other. The center post defines a middle pin bore and is slidingly disposed within the aperture and configured for engaging a valve stem of a valve of an internal combustion engine. The locking pin assembly selectively couples together and decouples the center post and the rocker arm. In addition, the locking pin assembly includes an actuating pin, a second pin member and a middle pin member. The actuating pin member is slidingly disposed at least partially within the first pin bore, the second pin member is slidingly disposed at least partially within the second pin bore, and the middle pin member is slidingly disposed at least partially within the middle pin bore. Further, the actuating pin member is in contact with the middle pin member and the middle pin member is in contact with the second pin member.

Applicants submit that claim 13 is not taught or disclosed by the references of record for at least the same reasons set forth with respect to claim 4. In particular, the Elendt reference does not provide a deactivation rocker arm assembly with the actuating pin member being in contact with the middle pin member and the middle pin member being in contact with the second pin member as recited in amended claim 13. For at least this reason, Applicants request that the rejection of claim 13 be withdrawn. As claims 14-16 and 18 depend either directly or indirectly from claim 13, these claims are also not taught or suggested by the references of record for at least the same reasons set forth with respect to claim 13.

Claim 6, 24 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Elendt reference in view of U.S. Patent No. 5,908,015 to Kreuter ("the Kreuter reference").

Claims 6, 24 and 25 are not obvious over the Elendt reference in view of the Kreuter reference. The Patent and Trademark Office's burden of establishing a *prima facie* case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)). Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the references are not properly combinable. Even if the references were combined, they do not teach or suggest the claimed invention.

In rejecting claim 6 of the present invention, the Examiner combined the valve drive in the Elendt reference with the return springs (2, 17) in the Kreuter reference stating that it would improve drive control. See *Office Action*, pg. 7. However, there is nothing in either of the references provide a motivation to add a dual spring mechanism, as shown the Kreuter reference, with the valve in the Elendt reference. It is well established that the motivation to combine the references cannot come from the present patent application. See *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572 (Fed. Cir. 1984).

Even if the references of record are combined, they still do not teach or suggest all of the limitations recited in claims 6 and 24. See *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). In particular, the Elendt reference does not teach or

suggest a locking pin assembly with the actuating pin member being in contact with the middle pin member and the middle pin member being in contact with the second pin member for at least the same reasons set forth with respect to claim

4. Furthermore, the Kreuter reference fails to add anything to the Elendt reference except to provide a duel spring assembly for a valve. As with the Elendt reference, the Kreuter reference fails to teach or suggest an actuating pin member in contact with the middle pin member and the middle pin member in contact with the second pin member , thereby failing to teach or suggest all of the limitations included in claims 6 and 24. Thus, Applicants request that the rejection of claims 6 and 24 be withdrawn. As claim 25 depends from claim 24, claim 25 is also not taught or suggested by the references of record for at least the same reasons set forth with respect to claim 24.

Claims 7-9 were objected to as being dependant upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. As such, claim 26 has been added and includes all the limitations of claims 6 and 7. In addition, claim 27 has been added to depend from claim 26 and includes the limitations of claim 8. Further, claim 28 has been added to depend from claim 27 and includes the limitations of claim 9. Applicants hereby submit that claims 26-28 are in proper form for allowance.

Conclusion

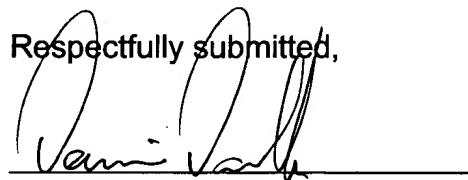
In light of the foregoing, Applicants submit that claims 4-9, 13-16, 18 and 24-28 are in condition for allowance and such allowance is respectfully

requested. Should the Examiner feel that any unresolved issues remain in this case, the undersigned may be contacted at the telephone number listed below to arrange for an issue resolving conference.

The Commissioner is hereby authorized to charge the \$86.00 fee for the additional independent claim that has been added to the present application, and any other fees that may have been overlooked, to Deposit Account No. 10-0223.

Dated: 2/11/04

Respectfully submitted,



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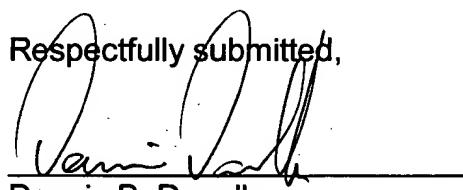
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